SKB Shutters Manufacturing Sdn Bhd v Seng Kong Shutter Industries Sdn Bhd & Anor

FEDERAL COURT (PUTRAJAYA) — CIVIL APPEAL NO 02(F)-97–12 OF 2014(W)
ZULKEFLI CJ (MALAYA), ABDULL HAMID EMBONG, JEFFREY TAN, APANDI ALI AND ABU SAMAH FCJJ
26 OCTOBER 2015

Patents — Infringement of — Action for — Whether patent invalid because it lacked novelty and inventive step — Whether Court of Appeal's findings of invalidation unsound — Whether each of eleven claims should be assessed individually for lack of novelty and/or inventive step — Whether dependent claims became invalid if independent claim invalid — Whether patent claim could be amended pending litigation — Whether Court of Appeal was correct to construe claims and compare them with prior art — Whether Court of Appeal erred in its findings that patent was invalid

The appellant and the first respondent were both in the business of dealing in roller shutters and related parts, while the second respondent was at all material times a director of the first respondent. The appellant was the registered proprietor of a Malaysian patent entitled 'Rolling Door' ('the patent') pertaining to the features and parts of a rolling door. The appellant alleged that by manufacturing, selling, offering for sale and using roller shutters which incorporated the features of the appellant's patent, the respondents had infringed the appellant's patent. The appellant filed an action against the respondents for infringement of the patent. In response the respondent pleaded that the appellant's patent was invalid by reason that it lacked novelty and an inventive step. The respondent further argued that there had been prior use of the patent in the form of an Aluminium PVC Piece ('the PVC piece'), which PVC piece had been sold in the market prior to the application date of the appellant's patent ie prior to 24 February 1997; and in the form of two United States Patents ('the US Patents') for roller shutter doors published prior to 24 February 1997. The High Court judge considered the question of novelty of the appellant's patent by making a comparison of the appellant's product with the PVC piece and the US Patents or the prior art. Based on the said comparison the High Court judge found that the appellant's patent was novel and thus allowed the appellant's claim against the respondents for infringement of the appellant's patent. On appeal the Court of Appeal held that the High Court judge erred when he made a comparison of the appellant's product with the prior art when considering the question of novelty of the appellant's patent when he should have compared the claims of the appellant's patent with the prior art. As the present case involved multiple claims the Court of Appeal

made a comparison between the features of the first claim ('claim 1') of the appellant with the PVC piece and found that the said claim was not novel and had been anticipated by the PVC piece. Consequently the Court of Appeal held that the patent was invalid and reversed the decision of the High Court. Hence the present appeal wherein the appellant submitted that the Court of Appeal's findings of invalidation were unsound because the invalidation of the appellant's entire patent was founded on only one invalid claim, namely claim 1. The appellant also contended that the Court of Appeal failed to assess each of the eleven claims individually for lack of novelty and/or an inventive step. As such, the appellants argued that those claims which had not been assessed individually ought not to have been declared invalid by the Court of Appeal. The respondents, on the other hand, agreed with the contention of the respondents that the Court of Appeal was correct to construe the claims and compare the claims with the prior art in finding that the appellant's patent was invalid.

Held, dismissing the appeal with costs:

(1) In the present case, of the eleven claims by the appellant, claim 1 and the eleventh claim were independent claims whereas claims 2 to 10 were dependent claims, being dependent on the preceding claims. Thus, all the claims were ultimately dependent on claim 1. On the issue of novelty, it was clear that the Court of Appeal had considered claim 1 and the eleventh claim and found them both to be invalid. As regards the dependent claims, ie claims 2 to 10, the Court of Appeal was entitled to hold that the appellant's patent was invalid as the rest of the claims, being claims dependent on claim 1, would also fall. The dependent claims in essence incorporated all the features of the claim upon which they depended but were drafted to only make reference to the claim upon which they depended without expressly setting out all the features of that claim. As such, in the event that the independent claim upon which they depended was invalid, the only way the dependent claim could survive and stand was if the dependent claims were redrafted to incorporate the features of the claim upon which they were dependent and were made independent claims. However, as that was not done in the present case and as it could not be redrafted, the dependent claims should fall. Further, there was no provision in the Malaysia Patents Act 1983 that allowed a patent claim to be amended pending litigation in respect of its validity or which allowed a partially valid patent to be enforced without amendment (see paras 22–29).

(2) On the issue of lack of inventive step it was clear that each of the 11 claims lacked an inventive step. Although the Court of Appeal did not expressly state that it had dealt with each of the said claims, it should be obvious it had (see para 30).

(3) The law is clear that when an invention, which is the subject of a patent claim lacks novelty or inventive step, one would look at the language of the claims, which defined the scope and monopoly claimed. Thus, it was ultimately the claims which had to be looked at and considered. On the facts of the present case, the device disclosed by the claims was not identical to the appellant's product. The appellant's product was in three parts but the claims of the appellant's patent did not restrict the device to three parts. As such, the appellant's product differed from the device as disclosed by the claims in the appellant's patent. In the circumstances, the Court of Appeal was correct to construe the claims and compare the claims with the prior art in finding that the appellant's patent was invalid (see paras 32–36).

(4) The Court of Appeal was entitled to construe the claims of the appellant's patent and compare them with the prior art. Any assistance required on the technology, technical terms and common general knowledge had been led through the evidence of the respondents' expert at trial, whose evidence was before the Court of Appeal. As the experts who educated the court on technology, technical terms and common general knowledge did not have to be approximate persons skilled in the art, the Court of Appeal was entitled to hold that neither the respondents' experts nor the appellant's expert were 'unimaginative skilled addressees' and yet make reference to their evidence on technical terms and common general knowledge when assessing if the claims of a patent were obvious (see paras 38–39 & 41.)

(5) For a patent to lack novelty, it had to be shown that the claimed invention had been anticipated in a single document and/or a single prior art. The Court of Appeal's reference to the fact that the PVC piece did not contain clear and unmistakable directions should be read in context. It was clear that the Court of Appeal held that the PVC piece did not contain clear and unmistakable directions to do what the inventor claimed to have invented. It was in the context that there were no literal written 'directions' disclosed by the PVC piece as the PVC piece was a device as opposed to a written publication. However, this did not equate to the Court of Appeal having found by that statement that the PVC piece did not destroy the novelty of the claims of the appellant's patent. The Court of Appeal had considered claim 1 and made a specific finding that all the elements found in the claim were found in the PVC piece and thus the claim was invalid (see paras 44–45).

[Bahasa Malaysia summary

Perayu dan responden pertama kedua-dua dalam perniagaan mengendalikan bidai beroda dan bahagian-bahagian yang berkaitan, manakala responden kedua adalah pada setiap masa matan pengarah responden pertama. Perayu adalah pemilik berdaftar suatu paten Malaysia bertajuk 'Rolling Door' ('paten

itu') yang berkaitan dengan ciri-ciri dan bahagian pintu beroda. Perayu mendakwa dengan mengeluarkan, menjual, menawarkan untuk jualan dan menggunakan bidai beroda yang menggabungkan ciri-ciri paten perayu, responden telah melanggar paten perayu. Perayu memfailkan tindakan terhadap responden bagi pelanggaran paten. Sebagai tindak balas responden mengaku bahawa paten perayu tidak sah oleh sebab bahawa ia tidak mempunyai sesuatu yang baru dan langkah merekacipta. Responden selanjutnya mendakwa bahawa telah ada terlebih dahulu penggunaan paten itu dalam bentuk suatu keping aluminium PVC ('keping PVC'), yang kepingan PVC itu telah dijual di pasaran sebelum tarikh permohonan paten perayu iaitu sebelum 24 Februari 1997; dan dalam dua bentuk paten Amerika Syarikat ('Paten AS') untuk bidai beroda yang telah diterbitkan sebelum 24 Februari 1997. Hakim Mahkamah Tinggi telah mempertimbangkan persoalan kebaharuan paten perayu dengan membuat perbandingan antara produk perayu dengan kepingan PVC dan Paten Amerika Syarikat atau seni terdahulu. Berdasarkan perbandingan itu hakim Mahkamah Tinggi mendapati bahawa paten perayu adalah baru dan dengan itu membenarkan tuntutan terhadap responden bagi pelanggaran paten perayu. Atas rayuan Mahkamah Rayuan memutuskan bahawa hakim Mahkamah Tinggi terkhilaf apabila beliau membuat perbandingan antara produk perayu dengan seni terdahulu apabila mempertimbangkan persoalan kebaharuan paten perayu walhal beliau sepatutnya membandingkan tuntutan paten perayu dengan seni terdahulu. Oleh kerana kes ini melibatkan tuntutan berganda Mahkamah Rayuan telah membuat perbandingan antara ciri-ciri tuntutan pertama ('tuntutan 1') perayu dengan kepingan PVC itu dan mendapati bahawa tuntutan tersebut tidak baharu dan yang telah dijangkakan dengan keping PVC. Oleh yang demikian Mahkamah Rayuan memutuskan bahawa paten itu tidak sah dan membatalkan keputusan Mahkamah Tinggi. Oleh itu rayuan ini di mana perayu berhujah bahawa penemuan Mahkamah Rayuan terhadap pembatalan itu tidak kukuh kerana pembatalan keseluruhan paten perayu telah diasaskan dengan hanya satu tuntutan tidak sah, iaitu tuntutan 1. Perayu juga menyatakan Mahkamah Rayuan gagal untuk menilai setiap sebelas tuntutan secara individu bagi ketiadaan sesuatu yang baru dan/atau langkah merekacipta. Oleh itu, perayu berhujah bahawa tuntutan yang belum dinilai secara individu sepatutnya telah tidak diisytiharkan tidak sah oleh Mahkamah Rayuan. Responden, sebaliknya, bersetuju dengan hujah responden bahawa Mahkamah Rayuan adalah betul untuk mentafsirkan tuntutan dan membandingkan tuntutan dengan seni terdahulu untuk mendapati bahawa paten itu perayu tidak sah.

Diputuskan, menolak rayuan dengan kos:

(1) Dalam kes ini, daripada sebelas tuntutan oleh perayu, tuntutan 1 dan tuntutan 11 adalah tuntutan berasingan manakala tuntutan 2 hingga 10 adalah tuntutan yang bergantung, yang bergantung kepada tuntutan

sebelumnya. Oleh itu, semua tuntutan itu akhirnya bergantung kepada tuntutan 1. Berhubung isu sesuatu yang baru, adalah jelas bahawa Mahkamah Rayuan telah mempertimbangkan tuntutan 1 dan tuntutan kesebelas dan mendapati kedua-duanya tidak sah. Berkenaan dengan tuntutan yang bergantung itu, iaitu tuntutan 2 hingga 10, Mahkamah Rayuan berhak untuk memutuskan paten perayu tidak sah sepertimana tuntutan yang lain, yang merupakan tuntutan yang bergantung kepada tuntutan 1, juga akan diputuskan tidak sah. Berkenaan dengan tuntutan yang bergantung itu, iaitu tuntutan 2 hingga 10, Mahkamah Rayuan berhak untuk memutuskan paten perayu tidak sah sepertimana tuntutan yang lain, yang merupakan tuntutan yang bergantung kepada tuntutan 1, yang juga akan diputuskan tidak sah. Tuntutan yang bergantung itu pada asasnya menggabungkan semua ciri-ciri tuntutan yang padanya ia bergantung tetapi telah dirangka untuk hanya merujuk kepada tuntutan yang padanya ia bergantung tanpa dengan jelas menyatakan segala ciri-ciri tuntutan itu. Oleh itu, sekiranya tuntutan itu tuntutan berasingan di mana mereka bergantung itu tidak sah satu-satunya cara tuntutan yang bergantung itu boleh bertahan dan berdiri adalah jika tuntutan yang bergantung itu telah digubal semula untuk menggabungkan ciri-ciri tuntutan pada mana mereka bergantung dan dijadikan tuntutan berasingan. Walau bagaimanapun, oleh kerana ia tidak dilakukan dalam kes ini dan kerana ia tidak boleh digubal semula, tuntutan yang bergantung itu tidak sah. Tambahan lagi, tidak ada peruntukan dalam Akta Paten Malaysia 1983 yang membenarkan tuntutan paten perayu dipinda semasa tindakan undang-undang belum selesai berkaitan kesahannya atau yang membenarkan paten itu sebahagiannya sah untuk dikuatkuasakan tanpa pindaan (lihat perenggan 22–29).

(2) Berhubung isu ketiadaan langkah merekacipta adalah jelas bahawa setiap satu daripada sebelas tuntutan tidak mempunyai langkah merekacipta. Walaupun Mahkamah Rayuan tidak dengan jelas menyatakan bahawa ia telah meneliti setiap satu daripada tuntutan tersebut, ia seharusnya jelas ia telah dilakukan (lihat perenggan 30).

(3) Undang-undang adalah jelas bahawa apabila suatu rekacipta, yang menjadi subjek sesuatu tuntutan paten perayu tidak mempunyai sesuatu yang baru atau langkah berdaya cipta, seseorang akan melihat bahasa tuntutan, yang mentakrifkan skop dan monopoli yang dituntut. Oleh itu, ia akhirnya tuntutan yang perlu melihat dan dipertimbangkan. Mengikut fakta kes ini, peranti yang dizahirkan oleh tuntutan tidak sama dengan produk perayu. Produk perayu adalah dalam tiga bahagian tetapi tuntutan paten perayu tidak menyekat peranti ini kepada tiga bahagian. Oleh itu, produk perayu berbeza daripada peranti seperti yang dinyatakan oleh tuntutan dalam paten perayu. Dalam keadaan ini, Mahkamah Rayuan adalah betul untuk mentafsirkan tuntutan itu dan

membandingkan tuntutan itu dengan seni terdahulu untuk mendapati bahawa paten itu perayu adalah tidak sah (lihat perenggan 32–36).

(4) Mahkamah Rayuan berhak untuk mentafsirkan tuntutan paten perayu dan membandingkan mereka dengan seni terdahulu. Apa-apa bantuan yang diperlukan mengenai teknologi, istilah teknikal dan pengetahuan am biasa yang telah dikemukakan melalui keterangan pakar responden dalam perbicaraan, mana keterangan di hadapan Mahkamah Rayuan. Sebagai pakar-pakar yang memberi pengajaran kepada mahkamah tentang teknologi, istilah teknikal dan pengetahuan am biasa tidak perlu merupakan orang yang lebih kurang mahir dalam seni, Mahkamah Rayuan berhak untuk memutuskan bahawa sama ada pakar-pakar responden atau ahli pakar perayu adalah 'unimaginative skilled addressees' tetapi merujuk kepada keterangan mereka berhubung istilah teknikal dan pengetahuan am biasa apabila menilai jika tuntutan paten adalah jelas (lihat perenggan 38–39 & 41).

(5) Untuk paten yang kekurangan sesuatu yang baru, ia perlu menunjukkan bahawa rekacipta yang dituntut yang telah dijangkakan dalam satu dokumen tunggal dan/atau seni terdahulu tunggal. Rujukan Mahkamah Rayuan kepada fakta bahawa kepingan PVC itu tidak mengandungi arahan yang jelas dan arahan yang tidak disangsikan perlu dibaca dalam konteks. Ia adalah jelas bahawa Mahkamah Rayuan memutuskan bahawa kepingan PVC itu tidak mengandungi arahan yang jelas dan terang untuk melakukan apa yang pencipta mendakwa telah dicipta. Ia adalah dalam konteks bahawa tidak ada secara literal 'arahan' yang ditulis yang didedahkan oleh kepingan PVC itu kerana kepingan PVC itu adalah peranti yang berbeza dengan penerbitan bertulis. Walau bagaimanapun, ini tidak sama dengan Mahkamah Rayuan mendapati kenyataan bahawa kepingan PVC tidak memusnahkan kebaharuan tuntutan paten perayu. Mahkamah Rayuan telah mengambil kira tuntutan 1 dan membuat penemuan spesifik bahawa semua elemen yang terdapat dalam tuntutan itu ditemui dalam kepingan PVC dan dengan itu tuntutan itu tidak sah (lihat perenggan 44–45).]

Notes

For cases on action for infringement, see 10(1) *Mallal's Digest* (5th Ed, 2015) paras 1265–1266.

Cases referred to

E I Du Pont De Nemours & Co v Imperial Chemical Industries Plc & Anor [2007] FCAFC 163, FC (refd)

Electric and Musical Industries Ltd & Ors v Lissen Ltd & Anor (1939) 56 RPC 23, HL (refd)

Rockwater v Technip France SA [2004] RPC 919, CA (refd)

A *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59, CA (refd)

Legislation referred to

Courts of Judicature Act 1964 s 78
B Patents Act 1983 ss 11, 12, 13, 14, 15, 16, 31(1), 36, 36(3), 56(2), (3), 58
Patents Act 1977 [UK] ss 63, 75
Patents Regulations 1986 regs 13(5), 14

C **Appeal from:** Civil Appeal No W-02–3099 of 2010 (Court of Appeal, Putrajaya)

Khoo Guan Huat (Kuek Pei Yee, Sri Richgopinath and Melissa Long with him) (Skrine) for the appellant.
D *Ambiga Sreenevasa (Janini Rajeswaran, Quah Su Enn, Adeline Yew and Gerald Samuel with her) (Ranjit Singh & Yeoh) for the respondents.*

Zulkefli CJ (Malaya) (delivering judgment of the court):

E INTRODUCTION

[1] This is the appellant's/plaintiff's appeal against the whole of the decision of the Court of Appeal in allowing the respondents'/defendants' appeal against the decision of the High Court of Kuala Lumpur. It was the F finding of the Court of Appeal that the appellant's Malaysian Patent No My-128431-A ('Patent 431') was invalid and that the appellant's claim against the respondents for infringement of the appellant's patent was therefore unsustainable. In consequence thereof, the Court of Appeal reversed the decision of the High Court in allowing the claim against the respondents for G infringement of the appellant's patent.

[2] The questions of law upon which leave as obtained read as follows:

(1) Where a patent comprises multiple claims, whether, in invalidating a patent for lacking novelty and/or inventive step, the Court must make a H determination on each and every claim.

(2) Where a patent comprises multiple claims, some of which are independent, and other claims which are dependent on the independent claims:

I (i) whether having determined that an independent claim of a patent lacks novelty and/or inventive step, the Court is required to assess the claim dependent from the said independent claims before invalidating a patent; and

(ii) whether having only determined that one or more claims of a patent

lack novelty and/or inventive step, the Court should invalidate those claims whilst preserving the patent in respect of the valid dependent claims.

(3) Where there is no dispute that the appellant's /plaintiff's product is an embodiment of the claims of the appellant's patent, whether, in assessing Prior Art to determine if the appellant's patent is anticipated by or is inventive over the Prior Art, it is permissible to compare features of the appellant's product to the features of the Prior Art.

(4) Whether, on a true construction of the case of *The General Tire & Rubber Co v The Firestone Tyre & Rubber Co Ltd & Ors* [1972] RPC 457, in particular the passage of Sachs LJ that was cited by the Court of Appeal, when the English Court of Appeal referred to ' ... To determine whether a patentee's claim has been anticipated by an earlier publication it is necessary to compare the earlier publication with the patentee's claim ... If the earlier publication so construed discloses the same device as the device which the patentee by his claim, so construed, asserts that he has invented, the patentee's claim has been anticipated, but not otherwise. In such circumstances the patentee is not the true and first inventor of the device and his claimed invention is not new ... ', a comparison between a device that is disclosed by the claims of a patent with a device that is disclosed by an earlier publication (or Prior Art) is permitted.

(5) In the event the answer to Questions 3 and 4 above are in the negative, whether, having determined that the Prior Art must be compared to the Patent Claims in assessing if the appellant's patent is anticipated by or is inventive over the Prior Art, it is open to the Court of Appeal to construe the Patent Claims without the assistance of persons skilled in the art.

(6) Upon finding that the expert witnesses could hardly be described as 'the unimaginative skilled addressee' in determining if there is inventive step in the appellant's invention or otherwise, whether it is permissible for the Court to refer to the evidence of such experts to make a finding that the concept embodied in the appellant's patent is common general knowledge in the field of mechanical engineering which would be obvious to a normally skilled but unimaginative addressee in the art.

(7) Where there is a finding that the Prior Art does not contain clear and unmistakeable directions to do what the inventor claims to have invented and where the Prior Art in itself does not disclose the device disclosed by the Patent Claims, whether it is permissible for the Court of Appeal to make a finding that the appellant's patent lacks novelty as it is anticipated by the Prior Art.

BACKGROUND FACTS

[3] The appellant is the registered proprietor of Patent 431 entitled 'rolling door'. The appellant's patent pertain to the features and parts of a 'rolling door'.

The appellant is in the business of manufacturing, distributing and dealing in roller shutters, roller doors and a wide range of shutters.

[4] The first respondent is also in the business of dealing in roller shutters and related parts. The second respondent who is a director of the first respondent was sued in his personal capacity as the sole proprietor of Sing Keong Enterprise which ceased business sometime in or about 2008.

[5] The appellant's claim against the respondents was, inter alia, for infringement of the appellant's patent. The appellant alleged that the respondents by manufacturing, selling, offering for sale and using roller shutters which incorporate the features of the appellant's patent, had infringed the appellant's patent.

[6] The respondents' essential defence was that the appellant's patent was invalid by reason that it lacked novelty and an inventive step by reason of the prior disclosure and or prior use of the following prior art:

(a) An Aluminium PVC piece ('the PVC piece') which PVC piece had been sold in the market since 1996, which date is prior to the application date of the appellant's patent on 24 February 1997.

(b) United States Patent No 5456305 ('US' 305 Patent') for 'Rollable or Foldable Shutter' filed on 18 January 1995 and published prior to 24 February 1997.

(c) United States Patent No 4433714 ('US' 714 Patent') for 'Roller Shutter Doors' filed on 23 October 1981 and published prior to 24 February 1997.

FINDINGS OF THE HIGH COURT

[7] The learned High Court judge held that Patent 431 was novel, did not lack an inventive step and was valid and allowed the appellant's claim against the respondents for infringement of the appellant's patent. In considering the question of novelty of the appellant's patent the learned High Court judge made a comparison of the appellant's product with the prior art.

FINDINGS OF THE COURT OF APPEAL

[8] The Court of Appeal reversed the decision of the High Court and held that the learned High Court judge erred when he made a comparison of the appellant's product with the prior art when considering the question of novelty of the appellant's patent when he should have compared the claims of the appellant's patent with the prior art. The Court of Appeal made comparison

between the features of claim (1) of the appellant with the PVC piece and found that the said claim was not novel and had been anticipated by the PVC piece.

[9] The Court of Appeal in arriving at its decision that the appellant's patent lacked an inventive step adopted the approach in *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59 and found that the appellant's patent was obvious to a skilled but unimaginative addressee in the art and lacked an inventive step.

PRINCIPLES OF PATENT LAW

[10] At the outset it would be appropriate here to state the relevant provisions of the law and the principles relating to patent. In Malaysia patent is a creature of statute and as a general rule the rights and protection thereof are found within the Patents Act 1983 ('the Act') and the Patents Regulations 1986 ('the Regulations').

[11] On 'Invention' s 12 of the Act states that:

(1) An invention means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology.

(2) An invention may be or may relate to a product or process.

[12] On 'Patentable Invention' s 11 of the Act states that:

> An invention is patentable if it is new, involves an inventive step and is industrially applicable.

In order for an invention to be granted a monopoly and protected under the Act, it must be new, involves an inventive step and be industrially applicable.

[13] On the meaning of 'Novelty' or 'New' s 14 of the Act defines what is new as follows:

(1) An invention is new if it is not anticipated by Prior Art.

(2) Prior Art shall consists of —

(a) everything disclosed to the public, anywhere in the world, by written publication, by oral disclosure, by use or in any other way, prior to the priority date of the patent application claiming the invention.

...

[14] An 'Inventive step' is defined in s 15 of the Act as follows:

An invention shall be considered as involving an inventive step if, having regard to any matter which forms part of the Prior Art under paragraphs 14(2)(a), such inventive step would not have been obvious to a person having ordinary skill in the art.

RIGHTS OF PATENT OWNER

[15] The owner of a patent shall have the exclusive right to inter alia exploit the patented invention. *'Exploitation'* is defined in the Act to include, when the patent is granted in respect of a product, the *'making, importing, offering for sale, selling or using the product and stocking such product for the purpose of offering for sale, selling and using'* (see s 36 of the Act).

INFRINGEMENT

[16] Infringement is the performance of any acts referred to in s 36(3) of the Act of the Act in Malaysia by a person other than the owner of the patent and without the agreement of the latter in relation to a product or a process falling within the scope or protection of the patent (see s 58 of the Act).

INVALIDATION OF A PATENT

[17] The court may invalidate a patent if inter alia that what is claimed as an invention in the patent is not an invention within the meaning of s 12 or is excluded from protection under s 13 or sub-s 31(1) or is not patentable because it does not comply with the requirements of s 11, 14, 15 and 16 (see s 56(2) of the Act).

[18] The grounds to invalidate a patent thus includes (i) if the patent is not new (s 14) or (ii) lacks an inventive step (s 15). Section 56(3) of the Act states that where it applies only to some claims or parts of a claim, such claims or parts of a claim may be declared invalid by the court and the invalidity of part of a claim shall be declared in the form of a corresponding limitation of the claim in question.

CLAIMS

[19] The claims define the invention in terms of the technical features of the invention (see reg 13(5) of the Regulations). The function of the claims is to define clearly and with precision the monopoly claimed so that others may know the exact boundaries of the area within which they will trespass. Their primary object is to limit and not to extend the monopoly. What is not claimed is disclaimed (see Terrell on the *Law of Patents*).

[20] The first claim is usually the main claim which is made as wide as

possible. The subsidiary claims refer to the main claim and include qualifying or explanatory clauses on the various integers of the main claim or optional features. They may also contain independent claims.

THE DEPENDENT CLAIMS

[21] Claims which include all the features of one or more of the other claims are known as dependent claims. They will, if possible at the beginning, contain a reference to the other claim or claims and will then state the additional features claimed (see reg 14 of the Regulations). A claim which is not dependent on another is known as an independent claim.

DECISION

Questions (1) and (2)

[22] We shall first deal with questions (1) and (2) together. Learned counsel for the appellant submitted that the Court of Appeal's findings of invalidation are unsound in its entirety, because the invalidation of entire Patent 431 following a finding of only one invalid claim and/or invalid parts of a claim is unsustainable in law. It was contended for the appellant that at most the Court of Appeal could only partially invalidate Patent 431.

[23] The appellant also contended that the Court of Appeal failed to assess each claim individually for lack of novelty and or an inventive step. As such, it was argued that those claims which had not been assessed individually ought not to have been declared invalid by the Court of Appeal.

[24] It is noted that claims (1) and (11) of the appellant's Patent 431 are independent claims. Claims (2) to (10) of the appellant are dependent claims, being dependent on the preceding claims. All are ultimately dependent on claim (1).

[25] On the issue of novelty, it is clear that the Court of Appeal considered claim (1). We are of the view that the Court of Appeal also considered claim (11). In fact the appellant's witness PW2 conceded that *'the US' 305 Patent is probably destructive of the novelty of claim (11)'.*

[26] As regards the rest of the claims which are dependent claims (claims (2) to (10)), we are of the view that having considered claim (11) and claim (1) and found them to be invalid, the Court of Appeal was entitled to then hold that the appellant's Patent 431 was invalid as the rest of the claims, being claims dependent on claim (1), would also fall.

[27] The dependent claims in essence incorporate all the features of the claim upon which it depends but are drafted to only make reference to the claim upon which it depends without expressly setting out all the features of that claim. As such, in the event that the independent claim upon which they depend is invalid, the only way the dependent claim can survive and stand if at all is if the dependent claims are redrafted to incorporate the features of the claim upon which they are dependent and are made an independent claim. They cannot remain as *'dependent claims'* when the claim upon which they depended is invalid. We agree with the contention of the respondents as that was not done in the present case and as it could not be redrafted, the dependent claims must fall (see the case of *E I Du Pont De Nemours & Co v Imperial Chemical Industries Plc & Anor* [2007] FCAFC 163).

[28] The position in Malaysia relating to amendments of patent claims must be distinguished from the position in the United Kingdom. In the United Kingdom, the patent claim can be amended pending litigation in respect of its validity (see s 75 of the UK Patents Act 1977). There is a further provision which gives the court in the United Kingdom express power to enforce the part of the patent which is found to be valid. Section 63 of the UK Patents Act 1977 states as follows:

> If the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the court or the comptroller may, subject to subsection (2) below, grant relief in respect of that part of the patent which is found to be valid and infringed.

[29] There is no such provision in the Malaysian Patents Act 1983 similar to the provisions of ss 63 and 75 of the UK Patents Act 1977. It is clearly by reason of the said provision of s 63 in the United Kingdom that one can enforce a partially valid patent without amendment. Section 56(3) of our Patents Act is clearly not the equivalent of s 63 of the UK Patents Act 1977. It merely states that some claims or part of a claim may be declared invalid which in our view it can only refer to the independent claims of a patent.

[30] On the issue of lack of inventive step we agree with the submissions of respondents that each of the 11 claims lacked an inventive step. Although the Court of Appeal did not expressly state that they dealt with each of the said claims, it should be obvious it must have been so dealt with in light of the submission of the respondents and the finding of a lack of inventive step in the appellant's Patent 431 with regard to claims 1 and 11.

[31] It is our judgment that questions (1) and (2) if answered can have no impact on independent claims (1) and (11). The questions are academic in so far as the independent claims are concerned.

Questions (3) and (4)

[32] We shall now deal with questions (3) and (4) together. Questions 3 and 4 relate to the principles of novelty on a comparison of the prior art to the device embodiment of the patent claims. It was submitted for the appellant that the learned High Court judge was at liberty to compare the appellant's device on the basis that it constituted the claimed invention in itself and that the principles of *The General Tire & Rubber Co v The Firestone Tyre & Rubber Co Ltd & Ors* do not exclude the comparison of a device disclosed by prior use with the device embodiment of a patent and/or patent claim in question.

[33] The respondents however submitted that when assessing the issue of novelty and inventive step the High Court ought to have compared the claims of the appellant's patent and not the appellant's product with the prior art. On this point the case of *The General Tire & Rubber Co v The Firestone Tyre & Rubber Co Ltd & Ors* held as follows:

> To determine whether a patentee's claim has been anticipated by an earlier publication it is necessary to compare the earlier publication with the patentee's claim.

[34] We are of the view the law is clear that when it has to determine if an invention which is the subject of a patent claim lacks novelty or inventive step, one looks at the language of the claims which define the scope and monopoly claimed (see the case of *Electric and Musical Industries Ltd & Ors v Lissen Ltd & Anor* (1939) 56 RPC 23). The reference in *The General Tire & Rubber Co v The Firestone Tyre & Rubber Co Ltd & Ors* to a device is still in the context of a device as disclosed by the claims. It is ultimately the claims which must be looked at and considered.

[35] We find on the facts of this case that the device disclosed by the claims is not identical to the appellant's product. The appellant's product is in three parts but the claims of the appellant's patent do not restrict the device to three parts. There was no concession by the respondents that the claims disclosed a three part product.

[36] As the appellant's product differs from the device as disclosed by the claims in the appellant's patent, questions (3) and (4) are in fact abstract and hypothetical, not relevant to the facts of this case and do not assist the appellant. We agree with the contention of the respondents that the Court of Appeal was correct to construe the claims and compare the claims with the prior art in finding that the appellant's patent was invalid.

Questions (5) and (6)

[37] We shall deal with questions (5) and (6) together. These two questions relate to the issue of whether there are requirements for patent construction and assessment by persons skilled in the art. It was submitted for the appellant that the Court of Appeal wrongly invalidated Patent 431 as it did so without the assistance of appropriate technical experts and/or without the sufficient backing of the technical evidence from persons skilled in the relevant art particularly on:

(a) the technical meaning and wording of the claims in light of the relevant art;

(b) the common general knowledge;

(c) the inventive concept of each claim in question;

(d) the differences between the inventive concept and the state of the art; and

(e) whether it is obvious.

[38] On the said questions (5) and (6) posed by the appellant we are of the view the general principles relating to the construction of patent claims and the role to be played by the 'experts' are well-established. The function of the expert is to educate the court in technology and that they come as teachers, as makers of the mantle for the court to don. For that purpose it does not matter if they do not approximate a person skilled in the art (see the case of *Technip France SA's Patent*). As such, clearly the court can construe patent claims without the assistance of a person skilled in the art. Any assistance required is from an expert and he need not approximate a skilled person.

[39] It is our judgment that the Court of Appeal was entitled to construe the claims of the appellant's patent and compare them with the prior art. Any assistance required on the technology, technical terms and common general knowledge had been led through the evidence of DW3, the respondents' expert at trial, whose evidence was before the Court of Appeal.

[40] As regards claims (4) to (11), a perusal of the same evinces that any additional features relate to simple concepts, are unambiguous and plain in meaning and in respect of which in our view required no explanation on the technical terms.

[41] We are of the considered view that as the experts who educate the Court on technology, technical terms and common general knowledge do not have to

approximate persons skilled in the art, the Court of Appeal was entitled to hold that neither DW3 (the respondents' experts) nor PW1 (the appellant's expert) were *'unimaginative skilled addressees'* and yet make reference to their evidence on technical terms and common general knowledge when assessing if the claims of a patent were obvious.

Question (7)

[42] Question (7) touches on principle of assessment of novelty. It was submitted for the appellant that the Court of Appeal's assessment of novelty on Patent 431 when compared to the PVC piece prior art was flawed in holding that the PVC piece did not contain clear and unmistakeable directions to do what the inventor claims to have invented.

[43] It was also contended for the appellant that the Court of Appeal had wrongly considered the 'diagrams' and 'drawings' in addition to the PVC piece in this part as they:

(a) did not form part of the prior art;

(b) were not led in evidence by either parties' experts; and

(c) which were not adduced at trial but only on appeal.

We are of the view the 'diagrams' and the 'drawings' submitted before the Court of Appeal were merely to assist the Court of Appeal in its assessment of novelty of claims 1 and 11 which contained drawings of the PVC piece already admitted in evidence as well as drawings of the appellant's patent which were from the patent itself and also already admitted in evidence. They were submitted to illustrate the features found in the claims and in the PVC piece for comparison. The diagrams and drawings were not a separate prior art.

[44] For a patent to lack novelty, it must be shown that the claimed invention has been anticipated in a single document and/or a single prior art. We are of the view the Court of Appeal's reference to the fact that the PVC piece did not contain clear and unmistakeable directions must be read in context. It is clear that the Court of Appeal held that the PVC piece did not contain clear and unmistakeable directions to do what the inventor claimed to have invented. It was in the context that there were no literal written 'directions' disclosed by the PVC piece as the PVC piece was a device as opposed to a written publication. However, this does not equate to the Court of Appeal having found by that statement that the PVC piece did not destroy the novelty of the claims of the appellant's patent.

[45] Having considered claim (1), the Court of Appeal made a specific finding that all the elements found in the claim were found in the PVC piece and thus the claim was invalid. Question (7) assumes the fact that the claims did not disclose the device disclosed by the prior art when this is inaccurate as a finding of fact had been made that it did. We are therefore of the view question (7) does not assist the appellant in its case against the respondents.

CONCLUSION

[46] For the reasons abovestated we, the remaining judges (see s 78 of the Courts of Judicature Act 1964) following the resignation of Mohamed Apandi Ali FCJ, as he then was, now Attorney General, find there is no merit in this appeal. The appeal is therefore dismissed with costs.

Appeal dismissed with costs.

Reported by Kohila Nesan